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PATENT APPLICATION

ATTORNEY DOCKET NO. 10991266-4

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): HELOT et al.

Confirmation No.: 1876

Application No.: 09/439,626

Examiner: Cuff, Michael A.

Filing Date: November 12, 1999

Group Art Unit: 3627

Title: A SYSTEM AND METHOD FOR ORDERING CONSUMER ITEMS IN ELECTRONIC COMMERCE

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on December 20, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

1st Month
\$120

2nd Month
\$450

3rd Month
\$1020

4th Month
\$1590

The extension fee has already been filed in this application.

(b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: HELOT et al. Confirmation No.: 1876
Serial No.: 09/439,626
Filing Date: November 12, 1999
Group Art Unit: 3627
Examiner: Cuff, Michael A.
Title: A SYSTEM AND METHOD FOR ORDERING
CONSUMER ITEMS IN ELECTRONIC COMMERCE
Docket No.: 10991266-4

MAIL STOP: APPEAL BRIEF PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Applicants have appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed November 2, 2005, finally rejecting Claims 29-48. Applicants filed a Notice of Appeal on December 20, 2005. Applicants respectfully submit herewith this Appeal Brief with authorization to charge the statutory fee of \$500.00.

REAL PARTY IN INTEREST

The present application was assigned to Hewlett-Packard Company as indicated by an assignment from the inventor recorded on March 6, 2000 in the Assignment Records of the United States Patent and Trademark Office at Reel 010665, Frame 0815. The present application was subsequently assigned to Hewlett-Packard Development Company, L.P. as indicated by an assignment from Hewlett-Packard Company recorded on September 30, 2003 in the Assignment Records of the United States Patent and Trademark Office at Reel 014061, Frame 0492.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-28 were canceled without prejudice or disclaimer, Claims 49-56 are considered as withdrawn as being directed toward a non-elected species, and Claims 29-48 stand rejected pursuant to a final Office Action mailed November 2, 2005. Claims 29-48 are presented for appeal.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the mailing of the final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the present invention as defined by independent Claim 29 are directed toward a computer-implemented ordering system (100, 300) comprising an interface (315) adapted to provide a representation of a consumer item and an option associated with the consumer item and a presentation module (320) adapted to provide a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the

option and indicate to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item (at least at page 7, lines 5-12; page 11, lines 2-30; page 12, lines 1-9; page 14, lines 15-24; page 15, lines 19-30; page 16, lines 1-15; and figures 1-3).

Embodiments of the present invention as defined by independent Claim 36 are directed toward a computer-implemented ordering method comprising providing a representation of a consumer item and an option associated with the consumer item, providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option, and indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item (at least at page 11, lines 2-30; page 12, lines 1-9; page 14, lines 15-24; page 15, lines 19-30; page 16, lines 1-15; and figures 1-4).

Embodiments of the present invention as defined by independent Claim 42 are directed toward a computer-implemented ordering system (100, 300) comprising a means (315, 320, 335, 340) for providing a representation of a consumer item and an option associated with the consumer item, a means (315, 320, 340, 350, 370, 375, 380) for providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option, and means (315, 320, 340, 350, 370, 375, 380) for indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item (at least at page 11, lines 2-30; page 12, lines 1-9; page 14, lines 15-24; page 15, lines 19-30; page 16, lines 1-15; and figures 1-4).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 29-48 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,331,858 issued to Fisher (hereinafter “*Fisher*”) in view of non-patent document “JavaScript Image Rollovers” by Taylor (hereinafter “*Taylor*”).

ARGUMENT

A. Standard

1. 35 U.S.C. § 103

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. Additionally, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1183 (Fed. Cir. 1991).

B. Argument

1. First Ground of Rejection (Claims 29-48)

Claims 29-48 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Fisher* in view of *Taylor*. Of these claims, Claims 29, 36 and 42 are independent. Applicant respectfully submits that each independent claim is patentable over *Fisher* and *Taylor*, alone or in combination, and thus remaining Claims 30-35, 37-41 and 43-48 which depend respectively from the independent Claims 29, 36 and 42 are also patentable.

Embodiments of the present invention generally involve a computerized system and method for enabling a user to view, modify and/or order a consumer item (at least at page 5, lines 22-28). For example, the consumer item (e.g., in the form of a base item and any available options for the base item) is presented or displayed to a user via a graphical user interface (GUI) or other type of interface enabling the user to interact with the system (at least at page 11, lines 11-17). Embodiments of the present invention also

enable the user to update the displayed consumer item with a desired option in real-time by clicklessly positioning a cursor over an icon corresponding to the option (at least at page 14, lines 13-24). For example, the present invention enables the consumer item to be updated with a desired option by positioning a cursor of a pointing device over the desired option without having to “click” on the desired option (at least at page 11, lines 15-24). Further, embodiments of the present invention indicate to the user the unavailability of another option based on the desired option (e.g., by “graying out” the other option and/or preventing the user from selecting the other option) (at least at page 15, lines 19-30, and page 16, lines 1-5). Accordingly, independent Claim 29, for example, recites “a presentation module adapted to provide a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option” and “the presentation module adapted to indicate to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item.”

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. For example, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness at least because the cited references, even when combined, do not teach or suggest all the limitations of independent Claims 29, 36 and 42.

In the final Office Action, the Examiner states: “*Fisher* shows all of the limitations of the claims except for specifying, in response to a user, clicklessly positioning a cursor over an icon and an audio preview” (Final Office Action, page 2). Applicants respectfully disagree. *Fisher* appears to disclose a system for displaying two web page frames where one of the web page frames illustrates a 3-dimensional display (e.g., an interior room) and the other web page frame contains a display of 2-dimensional finish samples (e.g., samples or swatches of fabrics) which are available for products or objects displayed in the first web page frame (*Fisher*, column 3, lines 35-45, column 4, lines 17-22, figures 3 and 5). *Fisher* also appears to disclose that “[m]arker icons are

displayed beside each sample” and that “[t]he marker icons identify objects in the 3D scene” (*Fisher*, column 4, lines 24-26, figures 3 and 5). *Fisher* also appears to disclose that “[t]he user can select the fabric to be applied, for example to the chair, by clicking on the chair marker beside the fabric sample (*Fisher*, column 4, lines 30-32, figures 2-4). *Fisher* does not appear to disclose or even suggest “indicat[ing] to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item” as recited by Claim 29. To the contrary, *Fisher* appears to be limited to providing only a single option (i.e., the fabric to be applied to the chair or curtain of *Fisher*) and, therefore, *Fisher* does not disclose or even suggest any other option depending on a selection of such fabric, let alone the unavailability of any other option. Moreover, *Taylor* does not appear to remedy, nor did the Examiner rely on *Taylor* to remedy, at least this deficiency of *Fisher*. Accordingly, for at least this reason, Claim 29 is patentable over the cited references.

Additionally, the Examiner has not explicitly identified any disclosure in either *Fisher* or *Taylor* corresponding to “indicat[ing] to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item” as recited by Claim 29, and none appears to exist in either *Fisher* or *Taylor*. In fact, with respect to the above-referenced limitation of Claim 29, the Examiner states:

It should be noted that while the current prior art does meet the current limitations, the examiner believes that the “graying out” of invalid options on a GUI is very well known in that field. The examiner mentions this to dissuade applicant from pursuing this line of claim language.

(Final Office Action, page 4). Applicants respectfully refer to M.P.E.P. § 2144.03(A) which recites:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known.

(emphasis in original). Further, M.P.E.P. § 2144.03(A) recites:

It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.

The Examiner has offered none of the required evidentiary support. Accordingly, for at least this reason also, the rejection of Claim 29 is improper.

Independent Claim 36 “providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option” and “indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item” (emphasis added), and independent Claim 42, as amended, recites “means for providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option” and “means for indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item” (emphasis added). At least for the reasons discussed above in connection with independent Claim 29, Applicants respectfully submit that independent Claims 36 and 42 are patentable over the cited references. For example, neither Fisher nor Taylor, alone or in combination, discloses, teaches or suggests “indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item” as recited by Claim 36 and 42. Accordingly, Claims 36 and 42 are also patentable over the cited references.

Therefore, for at least the reasons discussed above, independent Claims 29, 36 and 42 are clearly patentable over *Fisher* in view of *Taylor*. Thus, Claims 29, 36 and 42, and Claims 30-35, 37-41 and 43-48 that depend respectively therefrom, are in condition for allowance.

CONCLUSION

Applicants have demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Applicants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is authorized to charge the statutory fee of \$500.00 to Deposit Account No. 08-2025 of Hewlett-Packard Company. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,



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CLAIMS APPENDIX

29. A computer-implemented ordering system, comprising:

an interface adapted to provide a representation of a consumer item and an option associated with the consumer item; and

a presentation module adapted to provide a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option, the presentation module adapted to indicate to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item.

30. The system of Claim 29, wherein the presentation module is adapted to update a stored representation of the consumer item updated with the option in response to the user clicking on the icon.

31. The system of Claim 29, wherein the option associated with the consumer item depends at least in part on a previously selected option.

32. The system of Claim 29, wherein the presentation module is adapted to provide attribute data associated with the consumer item.

33. The system of Claim 29, wherein the presentation model is adapted to automatically update in real-time attribute data associated with the preview representation of the consumer item updated with the option.

34. The system of Claim 29, wherein the presentation module is adapted to prevent selection of the option by a user in response to a previously selected option by the user.

35. The system of Claim 29, wherein the presentation module is adapted to provide an audio preview representation of the consumer item updated with the option.

36. A computer-implemented ordering method, comprising:
 - providing a representation of a consumer item and an option associated with the consumer item;
 - providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option; and
 - indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item.
37. The method of Claim 36, further comprising updating a stored representation of the consumer item updated with the option in response to the user clicking on the icon.
38. The method of Claim 36, further comprising providing attribute data associated with the consumer item.
39. The method of Claim 36, further comprising automatically updating in real-time attribute data associated with the preview representation of the consumer item updated with the option.
40. The method of Claim 36, wherein providing a representation comprises providing an audio preview representation of the consumer item updated with the option.
41. The method of Claim 36, further comprising preventing selection of the option by a user in response to a previously selected option by the user.
42. A computer-implemented ordering system, comprising:
 - means for providing a representation of a consumer item and an option associated with the consumer item;

means for providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option; and

means for indicating to the user unavailability of at least one other option associated with the consumer item based on the update to the consumer item.

43. The system of Claim 42, wherein the means for providing a real-time preview representation comprises means for updating a stored representation of the consumer item updated with the option in response to the user clicking on the icon.

44. The system of Claim 42, wherein the means for providing a real-time preview representation comprises means for providing attribute data associated with the consumer item.

45. The system of Claim 42, wherein the means for providing a real-time preview representation comprises means for automatically updating in real-time attribute data associated with the preview representation of the consumer item updated with the option.

46. The system of Claim 42, wherein the means for providing a real-time preview representation comprises means for preventing selection of the option by a user in response to a previously selected option by the user.

47. The system of Claim 42, wherein the means for providing a real-time preview representation comprises means for providing an audio preview representation of the consumer item updated with the option.

48. The system of Claim 42, further comprising means for acquiring statistical data associated with the consumer item.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None